

REMARKS/ARGUMENTS

A. In the Specification

Paragraphs [0061] and [0063] have been amended in the specification to clarify previously disclosed matter and/or to disclose industry known definitions at the time of filing.

B. Pending Claims

1. Applicant acknowledges that claims 47 and 48 are currently pending.
2. Applicant acknowledges that the terminal disclaimer filed on 12/19/2005 has been recorded.

C. Double Patenting

3. Amended claim 47 and new claim 48 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,260,146. Applicant acknowledges that although the conflicting claims are not identical, they are not patentably distinguishable. Applicant also acknowledges that a timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application, and further, that a registered attorney or agent of record can sign a terminal disclaimer.

Accordingly, attached hereto is a terminal disclaimer filed in compliance with 37 C.F.R. 1.321(c) and properly signed by Richard D. Clarke, the registered attorney of record. Therefore, Applicant respectfully requests that the double patenting rejection of claim 47 and claim 48 be removed.

4. Amended claim 47 and new claim 48 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 5,770,846. Applicant acknowledges that although the conflicting claims are not identical, they are not patentably distinguishable. Applicant also acknowledges that a timely filed terminal disclaimer in compliance with 37 C.F.R. 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application, and further, that a registered attorney or agent of record can sign a terminal disclaimer.

Accordingly, attached hereto is a terminal disclaimer filed in compliance with 37 C.F.R. 1.321(c) and properly signed by Richard D. Clarke, the registered attorney of record. Therefore, Applicant respectfully requests that the double patenting rejection of claim 47 and claim 48 be removed.

D. In the Claims

Regarding the Claim Rejections under 35 U.S.C. 112

5. Applicant acknowledges the quotation of the appropriate paragraph of 35 U.S.C. 112 that forms the basis for the rejections under this section made in the office action. Claim 47 was rejected under the first paragraph of 35 U.S.C. 112 as failing to comply with the written description requirement.

Claim 47 contained the term "hybrid chip card" which was not indicated per se in the specification. At the time of filing, the terms "smart card" and "hybrid chip card" were commonly defined and well known in the transaction card industry. However, there were two distinct possible definitions. One definition, as cited by the Examiner, involves contact or contact less functionality incorporated into a chip card (or smart card) design with two integrated circuits, or "chips" having separate interfaces, or a single chip supporting multiple interfaces. This definition referred to "hybrid" chips located on the card.

Another, more common definition, is a card having both a microprocessor chip and another medium, such as a magnetic stripe. This definition refers to “hybrid” types of storage media located on the card. Applicant espoused this latter definition in its disclosure, by specifically pointing out in the detailed description of **FIG. 6b** “a medium **652**, such as a magnetic stripe, is fixed to the exterior of a chip card **650**.” This is what Applicant meant by a hybrid chip card. Not a card with two chips, but a card with two most common data storage mechanisms, a chip and a magnetic stripe.

Applicant has attempted to clarify the disclosure by amending paragraph [0061] and [0063] and making it unequivocal that the definition was to be understood as a chip card having a magnetic stripe medium affixed thereto, or some other form of media. This definition of a hybrid chip card was well known to the smart card applications industry at the time of filing. No new matter was added.

Additionally, to avoid further confusion in the claims, the term “hybrid” was deleted so that the claims read “chip card” only. In this regard, Applicant believes that claim 47 is now in condition for allowance and respectfully requests that examiner allow claim 47 in due course.

Claim 48 also contained the term “hybrid chip card” which was not indicated per se in the specification. Likewise, paragraphs [0061] and [0063] have been amended as well as the term “hybrid” removed from claim 48. In this regard, Applicant believes that claim 48 is now in condition for allowance and respectfully requests that examiner allow claim 48 in due course.

Claim 48 further contained the term “a second portion of the information stored within a magnetic stripe on a hybrid chip card” which was not indicated per se in the specification.

In the specification Applicant continually refers to a magnetic stripe having a first and second information portion. When, in FIG 6b, the chip card with the magnetic stripe fixed to its exterior was introduced, it was meant by Applicant that this magnetic stripe would have the same characteristics as the one previously described, apart from the chip card. Thus, the magnetic

stripe was the same in nature and characteristics, both located on, and apart from, the chip card. It was to be understood, and it is routinely understood in the industry, that the nature and characteristics of the magnetic stripe on each of the types of cards is exactly the same. Therefore, both have two portions for information, namely, a first portion and a second portion. Someone skilled in the art of magnetic stripe data storage would know this prior to and upon reading the disclosure.

Applicant has deleted the term hybrid from the language of claim 48 to avoid confusion. The magnetic stripe data storage element recited in claim 48 would have the same characteristics as the magnetic stripe element in each and every claim, regardless of whether it was associated with the chip card or a simple magnetic stripe only card. In this regard, Applicant believes that claim 48 is now in condition for allowance and respectfully requests that examiner allow claim 48 in due course.

6. Response to Arguments

Applicant acknowledges that Applicant's arguments filed 12/19/2005 with respect to claims 47 and 48 have been fully considered and are persuasive. Thus, the 35 USC 102(b) rejection of claim 47 has been withdrawn.

7. Allowable Subject Matter

Applicant acknowledges that claims 47 and 48 would be allowable if re-written or amended to overcome the rejections under 35 USC 112, set forth in the Office Action. Applicant has hereby amended claim 47 and 48 and now believes that both claims are in condition for immediate allowance.


CONCLUSION

All of the rejections raised by the Examiner have been addressed by Applicant. Attorney for Applicant has carefully reviewed the double patenting rejections, and believes that the terminal disclaimers submitted herein should place the claims in condition for allowance. Each of the 112 rejections has been reviewed and addressed. In view of the amendments to the disclosure and claims, and the remarks submitted herein, Applicant submits that all of the amended claims of record are now in condition for allowance and respectfully requests that a Notice of Allowance be issued in this case in due course.

If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this application to allowance, the Examiner is invited to contact the undersigned, attorney of record in this case, Richard D. Clarke, Esq., at one of the listed below numbers or at his below listed e-mail address.

Dated: April 6, 2006

Respectfully Submitted,
LAW OFFICE OF RICHARD D. CLARKE

By 
Richard D. Clarke
Attorney for Applicant
USPTO Reg. No. 38,846

Customer No. 22890

Richard D. Clarke
Law Office of Richard D. Clarke
3755 Avocado Blvd., #1000
La Mesa, CA 91941-7301

Telephone: 619-670-1702
Facsimile: 619-670-7585
Email: rclarkeesq@sbcglobal.net